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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,191	09/14/2007	Nina Miikki	0696-0243PUS1	9230
2292 7590 03/09/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER FORTUNA, JOSE A				
ART UNIT 1741		PAPER NUMBER		
NOTIFICATION DATE 03/09/2011		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/585,191

**Applicant(s)**

MIIKKI ET AL.

**Examiner**

José A. Fortuna

**Art Unit**

1741

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 5-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Claim Rejections - 35 USC § 103**

1. Claims 1 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brownfield, US Patent No. 6,306,493 as evidenced by JP-2003-013395 A, referred hereafter as JP'395 or DE 3431577 or Doublet, WO 03/097937 A2 or Doublet et al., US Patent no. 6,402,888 or Sundberg, US Patent No. 5,989,389 or Crane, US Patent No. 4,552,617, just to mention a few.

Brownfield teaches a laser marked/burned web, which is made using papermaking pulps in which micronized polymers are added to the pulp, (the additives claimed in 4 of the present application), see abstract. Brownfield teaches that the laser marks are done at high speed, column 1, lines 18-22 by placing it, the web, in a path with the laser beam, column 2, lines 47-59. Brownfield teaches that the web that the process produces crisp edges and high contrast on any laser-markable paper or board, see column 2, lines 47-52. Brownfield teaches also that the web is made with the same type of pulps as claimed and that can be coated to cover the marks in the web, column 2, line 61 through column 3, line 52. Brownfield teaches the different use of the web and teaches that the web can be laminated with other type of papers/web, see column 5, lines 1-30. Note that Brownfield teaches that the paper can be laser marked and then coated or laminated with other type of papers or that the paper can be coated with a coating composition containing the absorber and then laser marking the paper, see column 1, lines 44-51 and column 3, lines 34-39. Also Brownfield teaches that the paper can be marked and the further processed, such as printing and coating or laminating with other type of papers, column 5, lines 27-

30 and examples 1-4 show papers which are not coated before marking, i.e., the absorber is added to the pulp slurry rather than to the coating slip. Even though Brownfield teaches that the web can be laminated, he's not specific as to how to do this, i.e., if done continuously on the papermaking machine or off the papermaking machine. However, laminating, i.e., forming a multi-ply product in which the marks of a marked paper are concealed between at least one lamina, ply, layer of paper or papermaking slurry is well known in the art as evidenced by the secondary references. Note that JP'395 teaches a process of making a marked multilayer/multiply webs in which a moving fibrous web **10** is marked and then papermaking fibrous slurry is deposited onto the marked web see figure 1b and abstract. JP'395 teaches that the markings/holes can be done by laser, see ¶-[0046] of the reference, (¶-[0019] of the detailed description on the machine translation). Note also that the secondary references teach that the paper could be added as a dried or already formed wet paper or as papermaking slurry added to the marked paper. Brownfield teaches that the laser marking can be done at high speeds, which implies that it is or can be done to the continuously in the papermaking operation or at the very least it would have been obvious to one of ordinary skill in the art to do so in view of the teaching of the JP'395 reference, which teaches that the marking can be done in the papermaking operation, i.e. to the moving web and therefore, this would have been obvious to one of ordinary skill in the art. Note that this is also shown by DE-341577 previously mentioned, see previous office action.

### **Response to Arguments**

2. Applicant's arguments with respect to claims 1 and 5-10 have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue with respect to Brownfield that he teaches a coated paper which is then market. This is partially true, because he also teaches that the marks can be done to the non-coated paper, i.e. by adding the absorber to the papermaking slurry see supra.

### **Conclusion**

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Laser Marked, Multilayered Papers."
4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew J. Daniels can be reached on 571-272-2450. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/  
Primary Examiner  
Art Unit 1741

JAF